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In re Application of	:	DECISION ON
PRELAS et al.	:	
Application No.: 09/600,279	:	PETITION UNDER
PCT No.: PCT/US99/00380	:	
Int. Filing Date: 15 January 1999	:	37 CFR 1.47(a)
Priority Date: 16 January 1998	:	
Attorney Docket No.: Q43649	:	
For: SOLID STATE ELECTRIC GENERATOR	:	
USING RADIONUCLIDE-INDUCED EXCITON	:	
PRODUCTION	:	

This is a decision on applicants' "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION UNDER 37 CFR 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 18 July 2001.

### **BACKGROUND**

On 15 January 1999, applicants filed international application PCT/US99/00380, which claimed a priority date of 16 January 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 22 July 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 16 August 1999, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 July 2000 (16 July 2000 being a Sunday).

On 14 July 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 04 August 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The NOTIFICATION set a one-month extendable period for reply.

On 05 February 2001, applicants submitted a petition under 37 CFR 1.47(a), which was

accompanied by, *inter alia*: a petition for a five-month extension of time; the fee for a five-month extension of time; the surcharge under 37 CFR 1.492(e); a series of declarations executed by four of the five joint inventors; a copy of several e-mails; and a copy of a letter sent to the non-signing joint inventor.

On 23 May 2001, the USPTO mailed a decision dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that factual proof that the missing joint inventor could not be found or reached after diligent effort had not been provided, nor had a proper oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor been provided.

On 18 July 2001, applicants submitted the instant "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION UNDER 37 CFR 1.47(a)" which was accompanied by a declaration of inventors signed by the previously nonsigning inventor Allister Dann.

### DISCUSSION

Because a declaration of inventors has been executed by the previously nonsigning joint inventor, the petition for status under 37 CFR 1.47(a) is moot. The application need not be returned to the Office of PCT Legal Affairs for any further consideration of the status under 37 CFR 1.47 regarding the inventor Allister Dann and no such status should be indicated on this application file.

The decision mailed 23 May 2001 discussed several issues regarding the declarations of inventors filed 05 February 2001. That decision stated in part:

The declaration executed Mark A. Prelas only identifies Mr. Prelas as an inventor and fails to identify the other four joint inventors. Additionally, (i) the declaration signed by Mr. Mountford lists Andrew W. Mountford as the inventor while the PCT application and the declarations signed by the other joint inventors list Andrew Mountford (without a middle initial) as the inventor and (ii) the declaration signed by Mr. Jennings lists Howard T. Jennings as the inventor while the PCT application and the declarations signed by the other joint inventors list Howard J. Jennings as the inventor. Attention is directed to MPEP § 605.04(c) if there has been a change of name and to MPEP § 605.04(g) if there is a typographical error.

Regarding the declaration executed by Mark A. Prelas, a new declaration signed by him is required as the declaration executed by him filed 05 February 2001 does not comply with 37 CFR 1.497(a)-(b) because it fails to identify all of the inventors.

As to the middle initial of Mr. Mountford, the difference in names is presumed not to be a name change or a change of inventors or a typographical error. The name Andrew Mountford is presumed to be a shortened version of the name Andrew W. Mountford and these names are

construed to designate the same person. (If this interpretation is incorrect, applicants are required to provide a written notification of this fact to the Office of PCT Legal Administration *immediately.*)

Regarding the declaration signed by Mr. Jennings, it also does not comply with 37 CFR 1.497(a)-(b) because it fails to identify the inventor Howard J. Jennings. The difference in the names of the inventor in the published international application (Howard J. Jennings in the published international application and the declarations signed by all of the joint inventors except Howard Jennings) and the declaration signed by a Mr. Jennings (Howard T. Jennings) must be explained. As noted in the decision mailed 23 May 2001, attention is directed to MPEP § 605.04(c) if there has been a change of name and to MPEP § 605.04(g) if there is a typographical error.

### **CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

Since the reply filed 18 July 2001 appears to have been bona fide, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b). Extensions of this time period may be granted under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.



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